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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,166	04/27/2001	Mitchell Corner	P 280189 50684/USw	8587

909 7590 11/25/2002

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EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

16

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,166

Examiner

Ellen M McAvoy

21
Applicant(s)

CORNER ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,8 and 11-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,8 and 11-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 8 November 2002 has been entered.

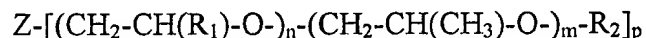
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8, and 11-23 rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw et al (4,851,144) in combination with Smalheer et al.

As previously set forth, McGraw et al ["McGraw"] disclose lubricant base oil compositions suitable for lubricating heat pumps and air conditioning compressors which comprise (A) about 95 to 5% by weight of a polyether polyol having a number average molecular weight from about 400 to about 5000 and having the formula



and (B) about 5 to 95% by weight of esters made from polyhydric alcohols with alkanolic acids or esters made from alkanedioic acids with alkanols. See column 2, lines 1-32. The examiner

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maintains the position that component (A) of McGraw meets the limitation of component (1) of applicants' claims when n is 0, R₂ is methyl and when Z is derived from methanol, ethanol, propanol and butanol as set forth in column 2, lines 51 to column 3, line 12. The examiner also maintains the position that component (B) of McGraw meets the limitation of component (2) of applicants' claims which has been amended to a polyol ester. McGraw allows for the addition of conventional additives to the composition such as antioxidants and corrosion inhibitors.

Although antifoam additives are not cited by McGraw, the examiner maintains the position that it would have been obvious to have added any conventional additive to the composition such as antifoam agents. Independent claims 1 and 15 include the limitation that "said lubricant does not form a stable emulsion with water", which, applicants argue, is not taught or suggested in the lubricants for compressors in McGraw. This is not deemed to be persuasive because the claims are drawn to a lubricant composition comprising components (1) and (2). McGraw discloses lubricant compositions which fall within the claimed invention which, inherently, also do not form stable emulsions with water.

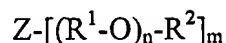
Claim Rejections - 35 USC § 103

Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward et al (RE 33,658) in combination with Smalheer et al.

As also previously set forth, Ward et al ["Ward"] disclose synthetic lubricants comprising (A) about 15 to 45 weight % of an ester of a monohydric alcohol of 4 to 18 carbon atoms with one or more aromatic or alkane dicarboxylic acids having 4 to 18 carbon atoms, and (B) about 85

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to 55 weight % of one or more polyether polyols having a number average molecular weight from about 400 to 5000 and having the formula



wherein Z is the residue of a compound having 1-8 hydroxyl groups, R^1 is an alkylene radical having 2 to 4 carbon atoms, and R^2 is hydrogen or an alkyl group of 1 to 6 carbon atoms.

Suitable monohydric compounds for Z include methanol, ethanol, propanol and butanol. See column 2, lines 63-67. Ward also allows for the addition of conventional additives and "any such additives as may be required". See column 3, lines 25-31. Thus, the examiner maintains the position that the synthetic lubricants of Ward which are specifically formulated for reciprocating air compressors also meet the limitations of the claims.

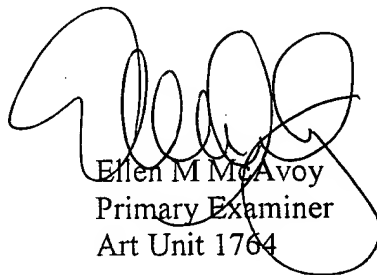
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
November 21, 2002